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PATENT
Docket No. 55679US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Conrad V. ANDERSON et al.)
Serial No.: 09/626,621)
Confirmation No.: 2487)
Filed: 27 July 2000)
For: GRAPHIC IMAGE FILM REGISTRATION SYSTEMS AND METHODS)

Group Art Unit: 1734
Examiner: Sue A. Purvis

APPELLANTS' BRIEF ON APPEAL

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Brief is presented in support of the Appeal filed August 20, 2003, from the final rejection of claims 1-25 and 34-47 of the above-identified application under 35 U.S.C. § 103, as set forth in the Final Office Action mailed May 20, 2003.

This Brief is being submitted in triplicate, as set forth in 37 C.F.R. § 1.192(a). A check to cover the fee for filing this Brief under 37 C.F.R. § 1.17(f) is enclosed herewith.

I. REAL PARTY IN INTEREST

The real party in interest of the above-identified patent application is the assignee, 3M Innovative Properties Company.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellants' Representatives that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

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III. STATUS OF CLAIMS

Claims 1-25 and 34-47 are pending and are the subject of this Appeal (see Appendix I).

IV. STATUS OF AMENDMENTS

The present Application was filed July 27, 2000, including claims 1-33.

A nonfinal Office Action (a copy of which is enclosed as Appendix II) was mailed from the U.S. Patent and Trademark Office on March 21, 2002, in which claims 1-33 were rejected under 35 U.S.C. § 103(a), as being unpatentable over allegedly admitted prior art in view of Krawczyk (U.S. Pat. No. 5,252,166) and Jensen, Jr. (U.S. Pat. No. 4,795,513).

Appellants filed a Response (dated June 20, 2002, a copy of which is enclosed as Appendix III) in which the rejection was traversed. No claims were amended.

A final Office Action (a copy of which is enclosed as Appendix IV) was mailed from the U.S. Patent and Trademark Office on August 29, 2002, in which the 35 U.S.C. § 103 rejection was maintained as described in the nonfinal Office Action mailed on March 21, 2002. Additionally, in the Examiner's response to Appellants' arguments, the Examiner introduced additional documents not previously cited (Hensley et al., U.S. Pat. No. 6,354,984; Shannon, U.S. Pat. No. 4,806,184; Mitchell, U.S. Pat. No. 4,490,198; Lerner et al., U.S. Pat. No. 4,412,876; and Fritz, U.S. Pat. No. 1,498,618).

No claims were found allowable.

APPELLANTS' BRIEF ON APPEAL

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For: GRAPHIC IMAGE FILM REGISTRATION SYSTEMS AND METHODS

Appellants filed a Response Under 37 C.F.R. § 1.116 (dated November 27, 2002, a copy of which is enclosed as Appendix V) in which the rejection was traversed and withdrawal of the finality of the previous Office Action was requested if the Examiner intended to rely on the newly cited documents (i.e., Hensley et al., U.S. Pat. No. 6,354,984; Shannon, U.S. Pat. No. 4,806,184; Mitchell, U.S. Pat. No. 4,490,198; Lerner et al., U.S. Pat. No. 4,412,876; and Fritz, U.S. Pat. No. 1,498,618) in maintaining the rejection of claims 7, 8, 24, and 25. No claims were amended.

A nonfinal Office Action (a copy of which is enclosed as Appendix VI) was mailed from the U.S. Patent and Trademark Office on December 10, 2002, in which the finality of the final Office Action mailed August 29, 2002 was withdrawn, and a restriction requirement under 35 U.S.C. 121 was made to a method of providing a composite image on a substrate (Group I, claims 1-25) and to an image graphic kit (Group II, claims 26-33). It was noted that a provisional election was made with traverse to prosecute the claims of Group I (claims 1-25) and the Examiner withdrew claims 26-33 from consideration.

The Examiner rejected claims 1-6 and 9-23 under 35 U.S.C. § 103(a), as being unpatentable over the allegedly admitted prior art in view of Krawczyk (U.S. Pat. No. 5,252,166) and Jensen, Jr. (U.S. Pat. No. 4,795,513).

The Examiner also rejected claims 8 and 25 under 35 U.S.C. § 103(a), as being unpatentable over the allegedly admitted prior art in view of Krawczyk and Jensen, Jr. as applied to claims 1, 5-7, 23, and 24, and further in view of Shannon (U.S. Pat. No. 4,806,184) or Fritz (U.S. Pat. No. 1,498,618). In this rejection the Examiner also referred to Mitchell (U.S. Pat. No. 4,490,198).

Additionally, the Examiner rejected claims 9 and 11 under 35 U.S.C. § 103(a), as being unpatentable over the allegedly admitted prior art in view of Krawczyk and Jensen, Jr. as

applied to claim 1, and further in view of Easter et al. (U.S. Pat. No. 4,620,888) or Roch et al. (U.S. Pat. No. 5,138,667). The Examiner also rejected claims 21-22 under 35 U.S.C. § 103(a), as being unpatentable over the allegedly admitted prior art in view of Krawczyk and Jensen, Jr. as applied to claim 1, and further in view of Shannon (U.S. Pat. No. 4,806,184).

No claim was found allowable.

Appellants filed an Amendment and Response (dated April 9, 2003, a copy of which is enclosed as Appendix VII) in which the provisional election of Group I (claims 1-25) was affirmed, withdrawn claims 26-33 were cancelled, and new claims 34-47 to methods of providing a composite image on a substrate were added. The rejections made in the nonfinal Office Action mailed December 10, 2002 were traversed.

A final Office Action (a copy of which is enclosed as Appendix VIII) was mailed from the U.S. Patent and Trademark Office on May 20, 2003, in which the Examiner rejected claims 1-7, 10, 12-20, 23, and 24 under 35 U.S.C. § 103(a), as being unpatentable over the allegedly admitted prior art in view of Krawczyk (U.S. Pat. No. 5,252,166) and Jensen, Jr. (U.S. Pat. No. 4,795,513). Additionally, the amendment to add new claims 34-47 was entered.

The Examiner also rejected claims 8 and 25 under 35 U.S.C. § 103(a), as being unpatentable over the allegedly admitted prior art in view of Krawczyk and Jensen, Jr. as applied to claims 1, 5-7, 23, and 24, and further in view of Shannon (U.S. Pat. No. 4,806,184) or Fritz (U.S. Pat. No. 1,498,618). In this rejection the Examiner also referred to Mitchell (U.S. Pat. No. 4,490,198). Additionally, the Examiner rejected claims 9 and 11 under 35 U.S.C. § 103(a), as being unpatentable over the allegedly admitted prior art in view of Krawczyk and Jensen, Jr. as applied to claim 1, and further in view of Easter et al. (U.S. Pat. No. 4,620,888) or Roch et al. (U.S. Pat. No. 5,138,667) and also rejected claims 21 and 22 under 35 U.S.C. § 103(a), as being

unpatentable over the allegedly admitted prior art in view of Krawczyk and Jensen, Jr., and further in view of Shannon (U.S. Pat. No. 4,806,184).

The Examiner also rejected claims 34-37, 39, and 41-47 under 35 U.S.C. § 103(a), as being unpatentable over the allegedly admitted prior art in view of Krawczyk, Shannon, and Jensen, Jr. Further, the Examiner rejected claims 38 and 40 under 35 U.S.C. § 103(a), as being unpatentable over the allegedly admitted prior art in view of Krawczyk, Shannon, and Jensen, Jr. as applied to claim 34, and further in view of Easter et al. (U.S. Pat. No. 4,620,888) or Roch et al. (U.S. Pat. No. 5,138,667).

No claim was found allowable.

A Notice of Appeal to the Board of Patent Appeals and Interferences was filed by Appellants on August 20, 2003, a copy of which is enclosed as Appendix IX.

V. SUMMARY OF THE INVENTION

Appellants' invention is directed to a method of providing a composite image on a substrate. The method includes a first film including a first portion of the composite image, a second film including a second portion of the composite image, first registration marks and second registration marks. Various embodiments of the method are claimed.

VI. ISSUE(S) PRESENTED FOR REVIEW

1. Whether claims 1-7, 10, 12-20, 23, and 24 are obvious under 35 U.S.C. § 103 over the prior art in view of U.S. Patent No. 5,252,166 (Krawczyk) and U.S. Patent No. 4,795,513 (Jensen, Jr.).

2. Whether claims 8 and 25 are obvious under 35 U.S.C. § 103 over the prior art in view of U.S. Patent No. 5,252,166 (Krawczyk) and U.S. Patent No. 4,795,513 (Jensen, Jr.), as

applied to claims 1, 5-7, 23, and 24, and further in view of U.S. Patent No. 4,806,184 (Shannon) or U.S. Patent No. 1,498,618 (Fritz).

3. Whether claims 9 and 11 are obvious under 35 U.S.C. § 103 over the prior art in view of U.S. Patent No. 5,252,166 (Krawczyk) and U.S. Patent No. 4,795,513 (Jensen, Jr.), as applied to claim 1, and further in view of U.S. Patent No. 4,620,888 (Easter et al.) or U.S. Patent No. 5,138,667 (Roch et al.).

4. Whether claims 21 and 22 are obvious under 35 U.S.C. § 103 over the prior art in view of U.S. Patent No. 5,252,166 (Krawczyk) and U.S. Patent No. 4,795,513 (Jensen, Jr.), as applied to claim 1, and further in view of U.S. Patent No. 4,806,184 (Shannon).

5. Whether claims 34-37, 39, and 41-47 are obvious under 35 U.S.C. § 103 over the prior art in view of U.S. Patent No. 5,252,166 (Krawczyk), U.S. Patent No. 4,806,184 (Shannon), and U.S. Patent No. 4,795,513 (Jensen, Jr.).

6. Whether claims 38 and 40 are obvious under 35 U.S.C. § 103 over the prior art in view of U.S. Patent No. 5,252,166 (Krawczyk), U.S. Patent No. 4,806,184 (Shannon), and U.S. Patent No. 4,795,513 (Jensen, Jr.), as applied to claim 34, and further in view of U.S. Patent No. 4,620,888 (Easter et al.) or U.S. Patent No. 5,138,667 (Roch et al.).

VII. GROUPING OF CLAIMS

For the purpose of this appeal, the claims can be separated into five groups in which the claims stand or fall together.

In Group I, claims 1-7, 9-17, and 19-24 stand or fall together.

In Group II, claim 8 stands or falls alone as reciting the removal of at least some of the second registration marks from the second film before applying the second film to the substrate. As discussed in more detail in the Argument section below, the cited references do not support the rejections of a claim reciting these features.

In Group III, claims 25, 37, and 44-46 stand or fall together. All of these claims recite removal of the second registration marks before the second film is applied to the substrate. As discussed in more detail in the Argument section below, the cited references do not support the rejections of the claims reciting these features.

In Group IV, claims 34-36 and 38-41 stand or fall together. All of these claims depend from independent claim 34 which recites "applying a first film to the substrate while inducing a constant stretch to the first film." As discussed in more detail below in the Argument section, the cited references do not support the rejections of the claims reciting that aspect of the invention (among others).

In Group V, claims 18, 42, 43, and 47 stand or fall together. All of these claims recite registration across the width of the films that includes detecting a distance between a leading edge and a trailing edge of one or a plurality of second registration marks. As discussed in more detail below in the Argument section, the cited references do not support the rejections of the claims reciting these features.

VIII. ARGUMENT

A. Claims 1-7, 10, 12-20, 23, and 24 are not obvious under 35 U.S.C. § 103(a) over the prior art in view of Krawczyk and Jensen, Jr.

"When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
(D) Reasonable expectation of success is the standard with which obviousness is determined." M.P.E.P. § 2141 (citations omitted).

Claims 1 and 23

1. The asserted admitted prior art, in view of Krawczyk and Jensen, Jr., does not suggest the desirability of making such combination to provide the claimed invention.

The Examiner, in the Office Actions mailed March 21, 2002, August 29, 2002, December 10, 2002, and May 20, 2003 (Appendices II, IV, VI, and VIII, respectively) relies upon the asserted admitted prior art in view of Krawczyk and Jensen, Jr. in rejecting claims 1 and 23. The Examiner asserts that all the elements necessary to arrive at a *prima facie* case of obviousness against claims 1 and 23 are present in the combination of the asserted admitted prior art, Krawczyk, and Jensen, Jr.

The Office Actions, however, fail to identify a proper suggestion or a motivation as to why one skilled in the art would have chosen to modify the asserted admitted prior art in view of both Krawczyk and Jensen, Jr. that is supported by the cited references, as discussed in Applicants' responses dated June 20, 2002, November 27, 2002, and April 9, 2003 (Appendices III, V, and VII, respectively).

It is asserted by the Examiner in each Office Action (Appendix II, IV, VI, and VIII), that "the instant specification teaches that previously a composite image was formed on the surface of a substrate manually by a skilled applicator who would pull or stretch each film slightly, thus varying its tension, as it was being applied to a registration between the different panels used to form the composite image." However, "[t]he admitted prior art does not teach using registration marks on the film and aligning those registration marks up" (Appendix II and

IV, page 2; Appendix VI, page 4; and Appendix VIII, page 2). It is also asserted that Krawczyk discloses a method of mounting multiple plastic sheets where . . . each portion has guidelines thereon for which are used to help align the design properly" (Appendix II, page 2; Appendix IV, page 3; Appendix VI, page 4; and Appendix VIII, page 2). The Examiner concludes, for example in the Office Action mailed March 21, 2002 (Appendix II), that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to include guides or registration marks in the method of the admitted prior art, because [for] a skilled artisan . . . there are instances where guidelines or registration marks would be helpful in aligning images on separate sheets as taught by Krawczyk."

The Examiner concedes in the Office Actions, for example in the Office Action mailed March 21, 2002 (Appendix II), that "[t]he admitted prior art in view of Krawczyk does not teach varying the tension on the second film along the length of the film to help ensure the marks are aligned properly", but that because Jensen, Jr. "teaches . . . ways of aligning webs" it would have been "obvious to one having ordinary skill in the art a the time the invention was made to vary the tension on the length second web thus stretching or shrinking the space between the registration marks" (Appendix II, page 3).

Appellants respectfully traverse these assertions and submit that the documents cited by the Examiner fail to support a proper *prima facie* case of obviousness. For example, the cited documents fail to support the asserted suggestion or motivation to modify or combine the reference teachings, because the proposed combination would change the principle operation of the prior art invention being modified. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious (M.P.E.P. 2143.01). Appellants' analysis as to how the proposed modification or combination of the prior art changes the principle of operation of the prior art is presented below.

Krawczyk teaches that "items to be subsequently mounted" are packaged in "plastic sheets" where "one sheet includes an adhesive layer that adheres to the front face of the item" (Abstract). Krawczyk recognizes that "added care must be used when urging the sheet 12 against loose pieces so as not to change the relative position of the various tile pieces" (Col. 7, lines 51-56). In other words, Krawczyk teaches that it is undesirable to change the relative positions of the tile pieces.

Applying the teachings of Jensen, Jr. to Krawczyk as asserted in support of this rejection would, however, necessarily result in changing the relative positions of the tile pieces as the sheet 12 was stretched, as taught by Jensen, Jr. This would result in a distorted composite image for Krawczyk, a result which Krawczyk teaches is undesirable. Thus, the proposed combination of Jensen, Jr. with Krawczyk would change the principle of operation of Krawczyk. One skilled in the art would not have been motivated to look to the asserted combination of the asserted admitted prior art, Krawczyk, and Jensen, Jr., as the combination of these documents would change the principle operation of the invention being modified. As such the teaching of the references are not sufficient to render the claims *prima facie* obvious.

For example, both Krawczyk and the asserted admitted prior art teach methods of applying sheets to a substrate in the form of discrete panels. In contrast, Jensen, Jr. teaches methods of processing continuous webs. The Examiner has identified no permissible motivation in any of the cited references as to why one of ordinary skill in the art would modify the asserted admitted prior art or Krawczyk in view of Jensen, Jr. Furthermore, to modify the teachings of the asserted admitted prior art in view of Jensen, Jr. as asserted would result in a change in the principle of operation of the asserted admitted prior art.

2. It is impermissible to use hindsight as an obviousness test.

Appellants respectfully submit that the use of the asserted admitted prior art in combination with Krawczyk and Jensen, Jr. in an obviousness rejection can only occur by the impermissible use of hindsight reasoning. In order to establish a *prima facie* case of obviousness, the references must teach or suggest all the claim limitations. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 at 93 ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, . . . was a legally improper way to simplify the difficult determination of obviousness."). One cannot "simply [to] engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). Further, both the suggestion for combining the teachings of the prior art to make the invention and the reasonable likelihood of its success must be founded in the prior art and not in the teachings of Appellants' disclosure. In re Dow Chem., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Here, the cited art neither suggests the combination of its teachings nor suggests the reasonable likelihood that such a combination would result in the present invention.

In the absence of a properly supported suggestion or motivation to combine all three reference teachings, the only way of arriving at the claimed subject matter is by picking and choosing individual elements from Krawczyk and Jensen, Jr. based on Appellants' disclosure. Nothing in the cited reference teachings would direct or motivate one skilled in the art to combine these three reference teachings as asserted in the absence of Appellants' own disclosure.

As the following claims are dependent, directly or ultimately, from either claim 1 or claim 24, Appellants assert that they are not obvious in view of the above comments.

Appellants, however, provide further comments below in support of the patentability of the claims dependent upon claims 1 and 23.

Claim 2

With respect to claim 2, the rejection is premised on the manual tensioning of the asserted admitted prior art, as modified by the teachings of Jensen, Jr. The Examiner, in the Office Actions (Appendices II, IV, VI, and VIII) fails, however, to provide any reasoning as to why or how one of skill in the art would make the leap from a manual, panel-by-panel installation technique in which tension is sporadically applied in a variety of directions (e.g., across the width and length of each panel) to a method in which tension is continuously applied along the length of the film. In the absence of any identified suggestion or motivation to make that modification, it must be assumed that impermissible hindsight forms the basis for the rejection of claim 2. As such, a proper *prima facie* case of obviousness for claim 2 has not been established.

Furthermore, the Examiner, at page 15 of the Final Office Action mailed May 20, 2003 (Appendix VIII) provides certain comments regarding Appellants' comments regarding claim 2, and refers to Shannon. Appellants respectfully point out, however, that the Examiner did not reject claim 2 in view of the Shannon document (U.S. Patent No. 4,806,184).

Claim 6

With respect to claim 6, Appellants note that none of the cited documents teach removal of registration marks from a film. Any assertion that Krawczyk teaches removal of guidelines from a film is not supported by the reference itself. In that regard, Appellants note that the section cited in support of the rejection of claim 6 (i.e., column 16, lines 43-47) teaches removing marks from the tiles, not the film, as recited in the claims.

Claims 7 and 24

Although not explicitly stated by the Examiner in the Final Office Action, mailed May 20, 2003 (Appendix VIII, page 4-5), it appears that claims 7 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art in view of Krawczyk (U.S. Patent No. 5,252,166) and Jensen, Jr. (U.S. Patent No. 4,795,513), and further in view of Hensley et al. (U.S. Patent No. 6,354,984 B1).

Claims 7 and 24 recite "removing a portion of the second film." It is asserted in the Final Office Action (Appendix VIII) that one would remove the second registration marks from the second film under a variety of circumstances. None of the assertions are, however, supported by a reference to the prior art. An attempt is made to rely on the teachings of Krawczyk in which the entire film is removed, with an assertion that because Krawczyk teaches removal of the entire plastic sheet, "it is the position of the examiner that to remove part of the sheet to remove the registration marks is within the purview of the artisan" (Appendix VIII, page 5).

That modification would, however, require a change in the principle operation of the prior art invention being modified. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious (MPEP § 2143.01). The plastic sheets of Krawczyk are used only as carriers. To leave a portion of the plastic sheet attached to the tiles would change the nature of the Krawczyk invention. For example, the plastic sheet remaining on the tiles would prevent the proper application of grout to the spaces between the tiles. As a result, any reliance on the teachings of Krawczyk as support for the removal of a portion of the film is misplaced.

The discussion regarding claims 7 & 24 also refers to Hensley et al. There is, however, no discussion in the Office Action as to how one of ordinary skill in the art would

apply the principles taught in Hensley et al. to any of the other cited references to reach the present invention.

Claims 10 and 12

With respect to claims 10 and 12, Applicants traverse the assertion that Krawczyk supports the rejection. The washable registration marks of Krawczyk are found on the tiles, not the plastic sheet itself.

Claim 15

With respect to claim 15, Appellants note that both Krawczyk and the asserted admitted prior art teach methods of applying sheets to a substrate in the form of discrete panels. In contrast, Jensen, Jr. teaches methods of processing continuous webs. Claim 15 recites that the second film is dispensed from a roll. The Examiner has identified no permissible motivation in any of the cited references as to why one of ordinary skill in the art would modify the asserted admitted prior art or Krawczyk (both directed to panel-by-panel application methods) in view of the continuous web processes of Jensen, Jr. To modify the teachings of the asserted admitted prior art in view of Jensen, Jr. as asserted would result in a change in the principle of operation of the asserted admitted prior art.

Claim 18

With respect to claim 18, Appellants note that the Examiner has never addressed where, in any of the cited references, any teaching or suggestion can be found regarding detecting distances between a "leading edge" and a "trailing edge" of registration marks. It may be helpful if the portion of the specification (p. 7, lines 3-27 and FIG. 1A) describing this concept is reviewed.

Merely detecting the existence of registration marks does not inherently require detecting the distance between the leading edge and the trailing edge of the registration mark. The rejections of claim 18 have failed to address this distinction in any manner.

Furthermore, the rejection fails to address where or how the prior art teaches or suggests that the distance measured between the leading edge and trailing edge of a registration mark "is indicative of a position across the width of the second film" as recited in claim 18.

For at least these reasons, Appellants submit that a *prima facie* case of obviousness has not been established with respect to claim 18.

Appellants further note that claim 18 has been identified as standing or falling with claims 42, 43, and 47.

Claim 19

With respect to claim 19, which recites "applying the first film to the substrate under tension," Appellants traverse the Examiner's assertion in the Final Office Action mailed May 20, 2003 (Appendix VIII, page 6) that the asserted admitted prior art teaches that first film is stretched or pulled during application. The first film need not be registered during application to a substrate in the prior art method because it is the first film, i.e., there are no other films to which the first film must be registered. As a result, any assertion that the limitations of claim 19 are taught in the prior art is misplaced.

For the reasons discussed above, Appellants submit that a *prima facie* case of obviousness has not been established with respect to claims 1-7, 10, 12-20, 23, and 24. Review and reversal of this rejection by the Board are respectfully requested.

B. Claims 8 and 25 are not obvious under 35 U.S.C. § 103(a) over the asserted admitted prior art in view of Krawczyk and Jensen, Jr., and further in view of Shannon or Fritz.

Claims 8 and 25 are ultimately dependent from claims 1 and 23. Thus, Appellants assert that these claims are patentable over the asserted admitted prior art in view of Krawczyk and Jensen, Jr. Appellants further assert that either Shannon or Fritz do not add that which is missing from Krawczyk and Jensen, Jr.

The Examiner's discussion regarding this rejection does not address a basic issue surrounding removal of the portion of the second film containing the registration marks "before the second film is applied to the substrate" as recited in claims 8 and 25. Removal of the registration marks before application of the second film raises issue as to how the registration can be accomplished (because there are no registration marks remaining on the film).

In fact, removal of the registration marks would contradict the teachings of one of the references relied on in support of this rejection. Jensen, Jr. teaches that the registration marks 19 on its film are sensed after laminating the film to the paper backing to ensure proper registration. See, e.g., Jensen, Jr., column 9, lines 36-41. Removal of the registration marks before applying the film to the paper backing would frustrate that purpose and could result in mis-alignment of the film on the paper backing. The Examiner does not, however, address this issue and Appellants submit that one of ordinary skill in the art would not be motivated to remove registration marks before applying the second film in view of the teachings of Jensen, Jr. to the contrary. Appellants assert, therefore, that neither Shannon nor Fritz address this basic issue with respect to claims 8 and 25. Thus, neither document provides that which is missing from Krawczyk and Jensen, Jr.

With respect to claim 25, it should be noted that claim 23 (from which claim 25 depends) recites "removing the second registration marks from the second film" in contrast to

claim 6 (from which claim 8 depends), which recites "removing at least some of the second registration marks from the second film." The arguments provided by the Examiner in support of the rejection of claims 8 and 25 fail to properly distinguish methods in which the second registration marks are removed (claim 25) and those in which only some are removed (claim 8) before the second film is applied to a substrate. Instead, the remarks provided in support of the rejection of claim 25 improperly assume that the claimed method involves removal of only some of the registration marks as opposed to "removing the second registration marks from the second film" as recited in claim 23 (from which claim 25 depends).

For the reasons discussed above, Appellants submit that a *prima facie* case of obviousness has not been established with respect to claims 8 and 25. Review and reversal of this rejection by the Board are respectfully requested.

Appellants further note that claim 8 has been identified as standing or falling alone and that claim 25 has been identified as standing or falling with claims 37 and 44-46.

C. Claims 9 and 11 are not obvious under 35 U.S.C. § 103(a) over the asserted admitted prior art in view of Krawczyk and Jensen, Jr., and further in view of Easter et al. or Roch et al.

Appellants submit that dependent claims 9 and 11 are patentable for at least the reasons presented above with respect to independent claim 1, from which claims 9 and 11 depend. While Easter et al. disclose an "invisible or nearly invisible registration mark" (column 5, line 68 to column 6, line 1, for example) in its method and apparatus for applying tubular labels, and Roch et al. disclose the use of a registration mark invisible to the naked eye (claim 3) in its process for detecting a printed registration mark, neither document add that which is missing from claim 1, i.e., a properly supported motivation to combine the teachings of the asserted admitted prior art with the teachings of Krawczyk and Jensen, Jr., as discussed above.

The addition of either Easter et al. or Roch et al., therefore, does not address the basic deficiencies of the rejection of claim 1.

For the reasons discussed above, Appellants submit that a *prima facie* case of obviousness has not been established with respect to claims 9 and 11. Review and reversal of this rejection by the Board are respectfully requested.

D. Claims 21 and 22 are not obvious under 35 U.S.C. § 103(a) over the asserted admitted prior art in view of Krawczyk and Jensen, Jr., and further in view of Shannon.

Appellants assert that dependent claims 21 and 22, dependent from claim 1, are patentable for at least the reasons presented with respect to independent claim 1, above. Furthermore, the addition of the teachings of Shannon does not provide that which is missing from claim 1. Shannon discloses a hand-held wallpaper applicator wherein the wallcovering material is applied from a rolled condition (Abstract). The Examiner admits that the length of material on the roll is not disclosed, but assumes that it would be more than 3 meters because the artisan would make the roll as large as possible to minimize the time to refill the roll (Appendix VIII, Final Office Action, page 8).

Appellants assert that the Examiner has not provided evidence that it is inherent in Shannon that the roll of wallcovering material must be greater than 3 meters. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

At column 6 of Shannon, under the section entitled, "OPERATION," it is disclosed that the material is "cut to the required length sufficient to cover the desired surface

(column 6, lines 42-43) prior to the material being positioned in the roller. Thus, Appellants assert that it is not inherent that Shannon discloses material of more than 3 meters.

Furthermore, even if Shannon disclosed a roll of material more than 3 meters, the addition of Shannon does not address the basic deficiencies of the rejection of claim 1. That is, it does not provide a motivation for the combination of the asserted admitted prior art with the teachings of Krawczyk and Jensen, Jr., as discussed above. The addition of Shannon, therefore, does not address the basic deficiencies of the rejection of claim 1, and Appellants respectfully submit that claims 21 and 22 are patentable as presented.

For the reasons discussed above, Appellants submit that a *prima facie* case of obviousness has not been established with respect to claims 21 and 22. Review and reversal of this rejection by the Board are respectfully requested.

E. Claims 34-37, 39, and 41-47 are not obvious under 35 U.S.C. § 103(a) over the prior art in view of Krawczyk, Shannon, and Jensen, Jr.

Claims 34-37, 39, and 41-43

Among claims 34-37, 39, and 41-43, claim 34 is the independent claim from which claims 35-37, 39, and 41-43 depend. For the reasons described above, Appellants assert that there is no motivation to combine the asserted admitted prior art with Krawczyk and Jensen, Jr., absent impermissible hindsight reconstruction as described in connection with, e.g., independent claim 1.

Krawczyk teaches that "items to be subsequently mounted" are packaged in "plastic sheets" where "one sheet includes an adhesive layer that adheres to the front face of the item" (Abstract). Krawczyk recognizes that "added care must be used when urging the sheet 12 against loose pieces so as not to change the relative position of the various tile pieces" (Col. 7,

lines 51-56). In other words, Krawczyk teaches that it is undesirable to change the relative positions of the tile pieces.

Applying the teachings of Jensen, Jr. to Krawczyk as asserted in support of this rejection would, however, necessarily result in changing the relative positions of the tile pieces as the sheet 12 was stretched, as taught by Jensen, Jr. This would result in a distorted composite image for Krawczyk, a result which Krawczyk teaches is undesirable. Thus, the proposed combination of Jensen, Jr. with Krawczyk would change the principle of operation of Krawczyk.

Furthermore, claim 34 recites a method of providing a composite image on a substrate. The method includes applying a first film to the substrate "while inducing a constant stretch" and applying the second film to the substrate while varying the tension along the length of the second film. Even if there was a motivation to combine the asserted admitted prior art with the teachings of Krawczyk and Jensen, Jr., Krawczyk, which teaches that it is undesirable to change the relative position of the tile pieces teaches away from claim 34, which recites applying a first film while inducing a constant stretch, and varying the tension along the length of the second film. Under a constant stretch, for example, the tiles of Krawczyk would not necessarily provide unchanged relative positions.

Shannon fails to add that which is missing from the combination of the asserted admitted prior art with Krawczyk and Jensen, Jr., namely, Shannon fails, as discussed above, to provide either a motivation to combine the asserted admitted prior art with the teachings of Krawczyk and Jensen, Jr.

Furthermore, Shannon also fails to teach or suggest a method wherein a constant stretch to the material is induced. While it may be desirable to maintain tension in wallpaper material during application, the Examiner does not provide any reasoning as to why it would be desirable to induce a stretch to the wallpaper material. In the absence of any such reasoning, the

assertion that the cited references teach or suggest the inducement of constant stretch is essentially an impermissible "obvious to try" rejection.

The Examiner's reasoning also falls short of establishing *prima facie* obviousness because it does not identify any motivation or suggestion to apply "a first film to the substrate while inducing constant stretch." Rather, the attempt to identify an motivation or suggestion to support this obviousness rejection merely asserts that "it is within the purview of the artisan to know that the film needs to be under tension to result in a smooth surface." (Appendix VIII, page 10). It should be noted that this assertion refers to tension, not stretch as recited in claim 34. As a result, this assertion fails to support a *prima facie* case of obviousness.

For at least these reasons, Appellants submit that a *prima facie* case of obviousness has not been established with respect to claims 34-37, 39, and 41-43. Review and reversal of this rejection by the Board are respectfully requested.

Appellants further note that, with respect to this rejection, claim 37 has been identified as standing or falling with claims 25 and 44-46 and its patentability is further addressed below.

Claims 37 and 44-46

Claims 37 and 44-46 all recite methods of providing a composite image on a substrate that includes removing the second registration marks from the second film before applying the second film to the substrate.

As discussed in connection with claim 25 above, the asserted admitted prior art in view of Krawczyk, Jensen, Jr., and Shannon does not support a *prima facie* case of obviousness with respect to claims that recite removal of the second registration marks before applying the second film. Those same arguments apply here to the rejection of claims 37 and 44-46.

Furthermore, the discussion provided in support of this rejection does not discuss why one of ordinary skill in the art would remove the second registration marks before applying the second film other than asserting that "it is within the purview of the artisan to cut it [the second film] before applying it to the substrate." That assertion does not, however, reach the claimed invention because the second registration marks are "distributed along a length of the second film" and a portion of the second registration marks would, thus, remain on the portion of the second film that is not trimmed off.

With respect to independent claim 44, Appellants further note that the arguments provided above with respect to the patentability of claim 1 also apply in connection with claim 44 and its dependent claims 45 and 46.

For at least these reasons, Appellants submit that a *prima facie* case of obviousness has not been established with respect to claims 37 and 44-46. Review and reversal of this rejection by the Board are respectfully requested.

Appellants note that claims 25, 37, and 44-46 have been identified as standing or falling together.

Claims 42, 43, and 47

As asserted above, there is no motivation to combine the asserted admitted prior art with the teachings of Krawczyk and Jensen, Jr., and Shannon fails to provide that which is missing from such combination which would provide Appellants' invention, as recited in claims 42, 43, and 47.

Claims 42, 43 and 47 all recite, among other things, methods of providing a composite image on a substrate that include detecting a distance between a leading edge and a trailing edge of one (claim 42) or a plurality (claim 47) of second registration marks, wherein the detected distance is indicative of a position across the width of the second film and steering the

second film to register the second portion of the composite image to the first portion of the composite image in a direction transverse to the length of the second film.

Appellants note that the Examiner has never addressed where, in any of the cited references, any teaching or suggestion can be found regarding detecting distances between a "leading edge" and a "trailing edge" of registration marks. Merely detecting the existence of registration marks does not inherently require detecting the distance between the leading edges and trailing edges of the registration marks. The rejections have failed to address this distinction in any manner.

Furthermore, the rejection fails to address where or how the prior art teaches or suggests that the distance measured between the leading edge and trailing edge of a registration mark "is indicative of a position across the width of the second film" as recited in claims 42 and 43.

For at least these reasons, Appellants submit that a *prima facie* case of obviousness has not been established with respect to claims 42, 43, and 47. Review and reversal of this rejection by the Board are respectfully requested.

Appellants note that claims 18, 42, 43, and 47 have been identified as standing or falling together.

F. Claims 38 and 40 are not obvious under 35 U.S.C. § 103(a) over the prior art in view of Krawczyk, Shannon, and Jensen, Jr., and further in view of Easter et al. or Roch et al.

Appellants submit that claims 38 and 40, dependent from claim 34, are patentable for at least the reasons presented above with respect to independent claim 34. Further, Appellants assert that neither Easter et al. nor Roch et al. add that which is missing from Krawczyk, Shannon, and Jensen, Jr.

While Easter et al. disclose an "invisible or nearly invisible registration mark" (column 5, line 68 to column 6, line 1, for example) in its method and apparatus for applying tubular labels, and Roch et al. disclose the use of a registration mark invisible to the naked eye (claim 3) in its process for detecting a printed registration mark, neither document add that which is missing from claim 34, a motivation to combine the teachings of the asserted admitted prior art with the teachings of Krawczyk and Jensen, Jr., as discussed above. The addition of either Easter et al. or Roch et al., therefore, does not address the basic deficiencies of the rejection of claim 34.

For at least these reasons, Appellants submit that a *prima facie* case of obviousness has not been established with respect to claims 38 and 40. Review and reversal of this rejection by the Board are respectfully requested.

APPELANTS' BRIEF ON APPEAL

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G. Summary

For the many foregoing reasons, it is respectfully submitted that a *prima facie* case of obviousness has not been established. It is earnestly requested that the Board reverse the rejections, and that all of pending claims 1-25 and 34-47 be allowed.

Respectfully submitted for

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By: 

Name: Rachel Gagliardi-Grubbs

(LARGE ENTITY TRANSMITTAL UNDER RULE 1.10)